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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/925,514  | 08/09/2001  | Larry Scheurich      | 6115-58352          | 4987             |
| 24197   | 7590        | 07/25/2005           | EXAMINER            |                  |
| KLARQUIST SPARKMAN, LLP<br>121 SW SALMON STREET<br>SUITE 1600<br>PORTLAND, OR 97204 |             |                      | DAVIS, GEORGE B     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2129                |                  |

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/925,514

Applicant(s)

SCHEURICH ET AL

Examiner

George Davis

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24 is/are rejected.
- 7) ☒ Claim(s) 1-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050721.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-22 and 24 are drawn to a computer-implemented method of refining a decision-making process, classified in class 707, subclass 3.
  - II. Claim 23 is drawn to a computer-implemented method of refining a budgetary decision-making process, classified in class 705, subclass 1.
2. The inventions are distinct, each from the other because each group is directed to separate invention.
3. Inventions group I and group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of group I has diagnosing a problem indicated by the state based at least on information while group II does not have diagnosing a problem indicated by the state based at least on information and group II has generate a budget and expense information for the cost centers while group I does not have generate a budget and expense information for the cost centers.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Gregory Maurer on July 21, 2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-22 and 24. Affirmation of this election must be made by applicant in replying to this Office action. Claim 23 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

7. Claims 1-22 are objected to because of the following informalities:

Claim 1, line 11, after "problem" insert - - ; - -.

Claim 1, lines 11 and 12, delete "and a user interface element indicating a possible reaction of a decision-maker to the diagnosis".

Claim 1, line 12, before “;” insert - - indicating a possible reaction of a decision-maker to the diagnosis by using a user interface element - -.

Claim 1, lines 13 and 14, delete “responsive to activation of the user interface element by decision-maker, recording the decision-maker’s reaction to the diagnosis” and insert - - recording the decision-maker’s reaction to the diagnosis in response to activation of the user interface element by decision-maker - -.

Appropriate correction is required.

Claim 2, delete all words in the claim and insert - - The method of claim 1 is performed by a computer-readable medium having computer-executable instructions - -.

### ***Allowable Subject Matter***

8. Claims 1-22 would be allowed if rewritten to overcome objection to claims set forth in this office action

The following is an examiner’s statement of reasons for allowance: The prior art Phung et al, U.S. Pat. Appl. No. 202/0007237 A1 teaches decision making to diagnose a problem (see section 0018). However, the claimed invention teaches diagnosing a problem indicated by the state based at least on information derived from results of processing of the one or more queries and indicating a possible reaction of a decision-maker to the diagnosis. Therefore, the prior art fails to teach or suggests diagnosing a problem indicated by the state based at least on information derived from results of processing of the one or more queries and indicating a possible reaction of a decision-

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maker to the diagnosis. In addition claims 1-22 are statutory because second paragraph of claim 1 recites data processing.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 23 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Phung et al, U.S. Pat. Appl. No. 202/0007237 A1.

As per claim 23, Phung recites refining a decision-making process based on a collection of data (section 0018), executing a set of discrete executable processing directives to diagnose a problem based on the collection of data (section 0018), distributing a diagnosis of the problem to a decision-maker (section 0018) and determining the decision-maker's reaction to the diagnosis (section 0018).

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Claim 23 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ahmed, U.S. Pa. App. No. 2002/0107824 A1.

As per claim 23, Ahmed recites refining a decision-making process based on a collection of data (sections 0069 and 0076), executing a set of discrete executable processing directives to diagnose a problem based on the collection of data (sections 0069 and 0076), distributing a diagnosis of the problem to a decision-maker (sections 0069 and 0076) and determining the decision-maker's reaction to the diagnosis (sections 0069 and 0076).


### ***Conclusion***

10. Applicant's arguments filed on May 11, 2005 have been fully considered and they are persuasive to overcome 35 U.S.C. 101 rejection. However, new ground of rejection is introduced in this office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Davis whose telephone number is (571) 272-3683. The examiner can normally be reached on Monday through Friday from 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight, can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3800.

July 21, 2005



GEORGE B. DAVIS  
PRIMARY PATENT EXAMINER